preventing connection of telephone calls if validation determines the call is not made by a caller in good standing; and

preventing continuation of telephone calls if validation determines the call is not continuing in good standing.

REMARKS

By this preliminary amendment, Applicant is deleting the recitation "travel" in all of the pending claims. Also, Applicant incorporates by reference his reasons urged in the response submitted before on November 9, 2000. A copy of that response is attached. The Examiner has stated some reasons that support her position. Applicant requests the Examiner to consider all of his prior arguments and requests a personal interview with the Examiner to discuss the divergent positions. In any event, the amendments to the claims present a different scope for the Examiner to consider.

Respectfully submitted,

Dated: August 17, 2001

By: Reena Kuyper
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MARKED-UP VERSION

29. (Amended) A telephone system of a type controllable by **[travel]** cards, comprising:

a switching station including a switch processor capable of receiving call data from at least one dial-up communication source and a switching computer means capable of processing call data;

said switching computer means controlling said switch processor;

communication means capable of capturing call data received by said switch processor, said call data including automatic number identification and a personal identification number;

said communication means capturing call data at front side of the call data received by the switch processor and supplying said call data to the switching computer means, and capable of supplying processed data from switching computer means to the switching station;

said switching computer means capable of obtaining data for at least one parameter related to a **[travel]** card in addition to said call data for the switching computer means to act upon in processing call data and determining from said data from the front side of the call data and additional parameter whether the attempted call is placed by a caller in good standing in accordance with parameters for the **[travel]** card;

said switching computer means capable of disallowing completion of a call through the switching station if determined from processing of call data and additional parameter by the switching computer means that the call is not placed by a caller in good standing; and

said switching computer means capable of interrupting and terminating said call in progress through the switch processor if said switching computer means determines by data processing that the available account status of the card has been reached during the call.

30. (Amended) The telephone system of the type controllable by cards as described in claim 29, further comprising a voice response device in electrical communication with said switch processor and said switching computer means, and capable of being in communication with at least one remote telephone, said voice response device with said switching computer means providing at least one of the following: to deliver a message to a caller using a **[travel]** card, to make a call through the telephone system, to prevent a caller using a **[travel]** card to make a call through the telephone system, to leave a message for at least one subsequent caller using a **[travel]** card to make a call through the telephone system, and to permit a caller using a **[travel]** card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a **[travel]** card customer.

31. (Amended) The telephone system of the type controllable by **[travel]** cards as described in claim 29, wherein said switch computer means performs a repeated failed attempts determination and directs the switching station through the communication means to prevent repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time.

32. (Amended) The telephone system of the type controllable by **[travel]** cards as described in claim 29, further comprising monitoring computer means electrically connected to said switching computer means and capable of storing call data, and a data storage server means electrically connected to the monitoring computer means and capable of access by **[travel]** card customers of the telephone system to provide current billing information to **[travel]** card customers.

33. (Amended) The telephone system of the type controllable by **[travel]** cards as described in claim 29, further comprising a voice response means being capable of communication with said switching computer means and in dial-up communication with callers to the telephone system, and capable of providing an oral report of current account status to **[travel]** card users.

34. (Amended) A telephone system of the type controllable by **[travel]** cards as described in claim 29 wherein the switching computer means determines from the call data and the data of the additional parameter at least one of the following for the switching station to act upon in processing call data: account balance status of the **[travel]** card at the beginning and during calls in progress, individual use test of the same personal identification number, geographically impossible calling with the same personal identification number, and unauthorized calling by the **[travel]** card user.

35. (Amended) A telephone system of the type controllable by **[travel]** cards as described in claim 29 wherein the switching station includes in addition an internal buffer capable of at least temporarily storing call data received by the switch processor, a conductor means capable of providing electrical communication of all call data from the switch processor to the buffer, and said communication means captures call data transparent to call data transfer from the switch processor to the internal buffer.

36. (Amended) A telephone system of the type controllable by **[travel]** cards as described in claim 35 wherein said communication means is electrically connected to such conductor means.

37. (Amended) A telephone system of the type controllable by **[travel]** cards as described in claim 29 wherein the communication means includes a port in the switch processor.

38. (Amended) A method of handling telephone calls by use of **[travel]** cards, comprising the steps of:

providing a switching station including a switch processor for receiving call data from at least one source capable of dial-up communication with said switch processor by use of a **[travel]** card and a switching computer means for processing call data received by said switch processor;

capturing call data received by said switch processor, said call data transmitted at dial-up including automatic number identification and a personal identification number;

delivering at least some captured data to said switching computer means;

supplying to said switch computer means at least one additional parameter related to the **[travel]** card to determine good standing;

processing in the switching computer means call data in relation to the received additional parameter data to determine if calls are placed and continued in good standing;

preventing connection of telephone calls if validation determines the call is not made by a caller in good standing; and

preventing continuation of telephone calls if validation determines the call is not continuing in good standing.

Patent
244/165 (prev. 6646-101NO)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	**Group Art Unit:** 2743
Ronald A. KATZ	**Examiner:** S. Woo
Serial No.: 09/364,731	
Filed: July 30, 1999	Office Action mailed: May 9, 2000
For: TELEPHONIC-INTERFACE STATISTICAL ANALYSIS SYSTEM	

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

Dear Sir:

In response to the Office Action dated May 9, 2000, please consider the following remarks and reconsider the application based on those remarks:

REMARKS

This Amendment is in response to the office action dated May 9, 2000. In the office action, the Examiner has rejected claims 29-48 under 35 U.S.C. Section 112 stating that the claims contain "*subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.*"

The Examiner indicated that claims 29-37 recite a "*telephone system of a type controllable by travel cards*" and claim 38 recites "*a method of handling telephone calls by use of travel cards.*" The Examiner believes that Applicant's specification "*contains no teaching or*

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this document (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

November 9, 2000
Date

Reena Kuyper
Reena Kuyper, Registration No. 33,830

LA-165171.1

suggestion of using 'travel cards,' which play the central role in the system of Marshall." The Examiner justifies this position with a statement that *"[a] telephone travel card is issued by a telephone company to enable a caller to place long distance calls over any phone and to charge the call to the account of the accountholder. The travel card authorization takes place at the telephone switching facility such that the call is not completed through the telephone network unless certain conditions are met. In contrast, applicant's specification describes the use of a credit card to authorize a transaction, such as a mail order transaction or lottery participation, which takes place over an already completed telephone connection. A travel card is used to authorize telephone call completion. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are completed to applicant's telephone-interface system without any prior qualification based on the credit card or lottery identification data. Therefore, applicant's credit card or lottery ticket cannot be considered as a 'travel card' which carries out a specific function in the telephony art."*

In response to the Examiner's above-stated position, Applicant respectfully urges the following position. As clearly stated in Applicant's specification, on page 4 thereof, Applicant indicates that *"the specific structural and functional details disclosed herein are merely representative.."* Accordingly, it is not important whether a card is called a *"travel"* card or by any other name (*"lottery"* or *"credit"* card as alleged by the Examiner), as long as use of the card is carried out in a similar way. Applicant respectfully negates the Examiner's position that Applicant merely describes *"the use of a credit card to authorize a transaction, such as a mail order transaction or lottery participation, which takes over an already completed telephone connection."* One might say that a telephone connection is not completed until a call is actually terminated. There is nothing in the claims themselves that suggests the distinctions between Applicant's specification and the claims that are urged by the Examiner. To attribute all the functionality urged by the Examiner as inherent to the term *"travel,"* an abstract designation, would seem improper.

To that end, Applicant respectfully urges the Examiner to consider pages 72 and 73 (copies attached) of the Court's "CONCLUSION OF LAW REGARDING PATENT CLAIM CONSTRUCTION" that relates to other claims issued to Applicant in his related patents. There, with respect to the term *"Products Carrying Participation Numbers,"* which would cover a so-called *"travel"* card, or *"lottery"* card, or any card carrying some kind of a participation number,

the defendants urged an argument to exclude *"prepaid calling cards."* Clearly, *"prepaid calling cards"* are used for making telephone calls under control of the telephone company. The Court concluded that *"products carrying participation numbers"* means: *"a physical item sold or exchanged in a commercial setting which carries a number allowing participation in the Katz system."*

Claims 29-37, 39-47 recite a *"switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing."* The Examiner finds that the Applicant's specification fails to provide support for this feature. The Examiner indicates that *"[i]n applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one is good standing, the completed call is terminated (page 13, lines 28-31)."* Therefore, the Examiner takes the position that *"applicant's specification does not provide support for the 'switching computer means being capable of disallowing completion of a call through the switching station if is it is determined...that the call is not placed by a caller in good standing' as recited in claims 29-37, 39-47 since in applicant's system, the call is completed through the switching facilities (communication facility C, ACD, switch 21) irrespective of the caller's standing."*

Applicant respectfully submits that he is puzzled by the Examiner's conclusion that the select processor cannot participate nor facilitate completion of the call. Looking at Figure 1 of Applicant's drawings, clearly a call initiated by one of the remote terminals, say T1, would progress via the communication facility (C), through one of the ACDs, say AC1, and finally via the processing system P1 (including an interface 20, a switch 21 and a processor PR1). The Examiner's claim that the call is completed through the switching facilities irrespective of the caller's standing is erroneous. On page 13 of his specification, Applicant clearly indicates that the *"resulting data signals are communicated from the interface 20 (FIGURE 1) to the processor PR1 for testing the telephone number as valid or entitled. Essentially, the format of a proper number prompts production of a valid or "good" signal. The test is indicated by the block 44 (FIGURE 3). If the response is not valid or entitled, for example contains an inappropriate*

number of digits or has been used to a point of excess, the operation of block 46 is initiated again cuing the voice generator 30 (Figure 1)..." (emphasis by underlining added).

Claims 38 and 48 recite *"preventing connection of telephone calls if validation determines the call is not made by a caller in good standing."* Again, the Examiner takes the position that *"Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not in good standing, the completed call is terminated (page 13, lines 28-31)."* Therefore, the Examiner takes the position that *"applicant's specification does not provide support for the step of 'preventing connection of telephone calls if validation determines the call is not made by a caller in good standing.'"*

Again, Applicant indicates that page 13 of his specification clearly describes the progression of a call through his system where his system determines if a telephone number is valid or entitled, either if it contains an inappropriate number of digits or if it has been used to a point of excess.

The Examiner further contends that Applicant's disclosure fails to provide support for the voice response device which is able to *"make a call through the telephone system," "prevent a caller using a travel card to make a call through the telephone system," "leave a message for at least one subsequent caller using a travel card to make a call through the telephone system,"* and *"permit a caller using a travel card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a travel card customer"* as recited in claims 30 and 40. Applicant respectfully submits that his interface 20 (incorporating a voice generator with voice capability (blocks 42, 56, 72, and 86)) is capable of performing the above-stated functions. The interface 20 with voice capability assists with the progression of a call through the processing system P1. It prevents a caller using a card if the caller is not entitled etc.

The Examiner further indicates that *"[a]pplicant's disclosure fails to provide support for performing a 'repeated failed attempts determination' and 'preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of*

invalid personal identification numbers with a predetermined period of time' as recited in claims 31 and 41." The Examiner finds that *"applicant's system provides for a use-rate calculator for determining and limiting the number of successful uses by a caller, not the number of failed attempts."*

However, Applicant points to page 13 of his specification, where his system determines if the caller has entered a proper telephone number or not. *"The caller is then allotted a predetermined period of time to make a proper entry ...[i]s the second try good?"*

Moreover, the Examiner indicates that *"[a]pplicant's disclosure does not provide support for 'a data storage server means...capable of access by travel card customers of the telephone system to provide current billing information to travel card customers' as recited in claims 32 and 42 or 'a voice response means being...capable of providing an oral report of current account status to travel card users' as recited in claims 33 and 43."* Applicant respectfully submits that the claimed language is adequately met by the support pointed out before, specifically, at page 40, lines 28-33.

Again, Applicant respectfully requests the Examiner to consider the foregoing remarks and institute an interference with U.S. Patent No. 5,790,636.

Respectfully submitted,
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Dated: November 7, 2000

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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

RONALD A. KATZ, TECHNOLOGY LICENSING, L.P., and MCI TELECOMMUNICATIONS CORPORATION,	:	CIVIL ACTION
Plaintiffs,	:	
v.	:	
AT& T CORPORATION, et al.,	:	
Defendants.	:	NO. 97-4453

TABLE OF CONTENTS

TO CONCLUSIONS OF LAW REGARDING PATENT CLAIM CONSTRUCTION

Page

I. THE LAW OF PATENT CLAIM CONSTRUCTION 2

A. CLAIM LANGUAGE 3

B. SPECIFICATION 4

C. PROSECUTION HISTORY. 6

D. EXTRINSIC EVIDENCE 7

E. MEANS PLUS FUNCTION LIMITATIONS. 8

II. CONSTRUCTION OF THE TWENTY CLAIMS PRESENTED AT THE MARKMAN HEARING. 11

A. ANALYSIS CONTROL SYSTEM CLAIMS. 11

1. "Communication Facility" 12

method of measuring use, such as a limited number of accesses into the Katz system.

B. CLAIMS INVOLVING PRODUCTS CARRYING PARTICIPATION NUMBERS

Claims Involving Products Carrying Participation Numbers are Claims 44 and 93 of the '707 patent and Claims 79 and 190 of the '863 patent. The text of these claims is set forth in the Appendix.

In general, these claims involve a method for limiting a caller's entitlement to access the functions of the system by requiring the caller to enter a participation number. These participation numbers are carried on products that are in some way provided to the caller prior to the call. The participation number corresponds to data stored in memory in the system which specifies a limit on a caller's access to the system.

1. "Products Carrying Participation Numbers"

The plaintiffs contend that the term "products carrying participation numbers" is straightforward and its meaning may be taken from the ordinary meaning of the words themselves. The defendants argue that the words "product" and "carrying" indicate that the product on which the participation number is carried must have inherent value apart from the number; thus, the defendants argue, "products" cannot include prepaid calling cards.

The term "products" is not used in the Katz patents as a term of art, as the parties agree. Thus, the Court should give the term its plain, ordinary English meaning. The Court concludes that the plain meaning of "products," which denotes an item produced for use in a commercial

71

setting, does not support the construction given to it by the defendants. The plain meaning of the term "product" in the claim language does not connote something of inherent value apart from the number carried with it.

The specification does not contradict the plain meaning of "products." The only place in the specification that discusses products carrying participation numbers is Column 17, lines 13 through 17 of the '707 patent, which reads "[a] key to participation in the game show may involve the purchase of a particular product. For example, a person desiring to participate may purchase a product which carries a concealed key number. The number serves as a caller's key to participation in the game show." This passage in no way suggests that the product must have value independent of the participation number. The defendants also point to Column 9, lines 35 through 38 of the '707 patent, which discusses restricting callers to the purchasers of a medical apparatus. This discussion is given by way of example only and does not indicate that all "products" must have inherent value apart from the participation numbers.

The defendants rely on statements made by Katz during the prosecution of the '707 patent. In the August 31, 1995 Amendment, Katz distinguished the '275 patent to Kamil by stating that "Kamil discloses a telephone system enabling prepayment for telephone calls, wherein special code and credit information is stored in memory in special exchanges and debited as the call progresses" and that Kamil "does not disclose specific limitation recitations including consumable key operation, nor does it disclose providing a product bearing a participation number specifying a limit on use." (Ex. 51). The defendants argue that Katz clearly stated that his invention was distinct from Kamil because Kamil used prepaid tickets which do not have inherent value, and thus, are not "products."

The Court concludes that Katz did not unambiguously state that his invention required

72

products with inherent value apart from the participation number; it is possible, for example, that Katz's distinction was based on the fact that Kamil's special code connected with the prepayment for telephone calls did not specify a limit on use. Katz did not mention Kamil's use of a prepaid ticket as a method of recording the prepayment in his statements so it is not clear that Katz was using the concept of a prepaid ticket as the basis for his distinction. In addition, these statements were made by Katz in a voluntary amendment, not in an effort to change the examiner's decision on a rejected claim. Thus, the Court concludes that Katz's statements do not indicate a clear disavowal of coverage so as to require that "products" have inherent value apart from the participation numbers. See York Products, 99 F.3d at 1575.

Based on the foregoing, the Court concludes that "products carrying participation numbers" means: a physical item sold or exchanged in a commercial setting which carries a number allowing participation in the Katz system.

2. "Accounting data"

The second term from the Claims Involving Products Carrying Participation Numbers that the parties have presented to the Court for construction is "accounting data." This term appears in Claim 44 of the '707 patent, which includes the step of "providing on-going accounting data to said individual callers at intervals during calls from said individual callers."

The plaintiffs argue that "accounting data" should be construed according to its ordinary, common meaning, which is information relating to a reckoning or a computation. (Pls.' App. 83-84). The defendants argue that "accounting data" means callers' scores in the television game show format because that is the only format in the specifications in which Katz discusses accounting data.